

REMARKS

Claims 1-19 are pending in this application. In the final office action mailed January 2, 2004, claims 1-3, 5-6, 8-9, and 11-19 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,401,859 (Widmer et al.) (office action, ¶ 2); and claims 4, 7, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,401,859 (Widmer et al.) (office action, ¶ 3). The specification has been amended and reconsideration is respectfully requested.

A certification of one of the inventors is submitted to counter the "Response to Arguments" in the office action, where the examiner states that the specification "clearly defines a textured surface...." As this contention is being raised for the first time, the certification is timely. M.P.E.P. § 716.01.

Rejections under 35 U.S.C. §§ 102(e) and 103(a)

The claims were rejected under either § 102(e) or § 103(a) in view of Widmer et al. To sustain a rejection based on anticipation under 35 U.S.C. § 102, "the reference must teach every element of the claim." M.P.E.P. § 2131 (8th ed., August 2001), page 2100-69. The M.P.E.P. goes on to state that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). However, Widmer et al. does not satisfy this requirement as it fails to disclose, teach, or suggest creating a texture on the surface; nowhere in the patent is there any mention of the word texture (or an equivalent thereto). Rather, Widmer et al. discusses adding grooves or ribs to the shell, but otherwise not modifying the surface of the shell itself; Widmer et al.'s surface remains smooth and untextured.

Indeed, although the action cites Figures 4-24 as examples of texture, most of the figures do not concern the outer surface of the device and, of those that do, they fail to disclose, teach, or suggest a texture, and all are inapposite for the following reasons:

Figures 4 and 5 are depictions of smooth surfaces (the lines in the figures are provided to illustrate curvature);

Figure 6 has "a venting groove" on an otherwise smooth surface (column 7, line 60);

Figures 7(a-f) and 8 illustrate various cross-sections for a venting groove; the surface itself is smooth;

Figures 9 and 10 are further examples of venting grooves" on an otherwise smooth surface;

Figures 11(a-e), and 12-14 all show structures internal to the device (note the dashed lines) and therefore the surface remains smooth;

Figures 15, 16, and 17 illustrate "fins or ribs 47 integrated into the inside of the shell" (column 11, line 10) [emphasis added];

Figures 22 and 23 are cross-sectional drawings; and

Figure 24 depicts a two-piece unit having a smooth exterior.

Only Figures 18-21 illustrate structures on the outside of the shell. Figures 18-20 depict a "pattern of ribs 51" (column 11, line 42). Figure 21 illustrates a device having a "corrugated or bellows-like section 63" while the surface remains smooth (column 12, lines 34-35). None of these constitute a texture as described and claimed in the application and as further described in the excerpt referenced on page 5 of the application.

In ¶ 4 of the office action (the section titled "Response to Arguments"), the application (page 5, lines 2-6) is quoted to support the argument that the claims encompass the cited reference, U.S. Patent No. 6,401,859 (Widmer et al.). This assertion misconstrues the quotation and urges an interpretation of the term "texture" contrary to the manner in which it is used in the application and as used by those skilled in the art. Certification of Martin W. Masters, ¶ 3. "Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." In re

Cortright, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111 (8th ed., rev. 1, February 2003), page 2100-47 (last paragraph in the left-hand column).

Therefore, a rejection based on an improper construction is not tenable.

In the application, texture is defined in part on page 2, lines 8-13, as follows:

By creating a textured, non-smooth finish on the outer shell of a hearing instrument, the hearing instrument will more readily lodge and remain within the ear canal. Further, the textured finish has an appearance closer to that of natural skin and therefore the hearing instrument is less noticeable to others, blending in with the visible portions of the ear.

To further illustrate the meaning of the term texture, the application refers to an excerpt from Marks' Standard Handbook for Mechanical Engineers, 9th ed., 1987, pages 13-75 through 13-81, titled "Surface-Texture Designation, Production, and Control." Page 6, lines 13-17. (Copy attached to the accompanying certification of Martin W. Masters.) By amendment, this excerpt has been incorporated by reference. The quoted section of the application and the cited excerpt distinguishes the claimed texture from the rib structures of Widmer et al. Finally, to respond further to the "Response to Arguments," the accompanying certification maintains that the textures described and claimed in the application are distinguishable from the structures disclosed in Widmer et al.


Because Widmer et al. does not disclose, teach, or suggest a textured surface, it cannot anticipate the claim. For at least this reason, the reference does not render the claimed combinations obvious. 35 U.S.C. § 103; M.P.E.P. § 2143.03 (8th ed., August 2001), p. 2100-126 ("[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"), citing In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974) [emphasis in original]. Additionally, there is no suggestion or teaching in Widmer et al. to modify the surfaces there in such a manner that would achieve the claimed textured surface. As the independent claims are allowable, dependent claims 3-7 and 9-12 are likewise allowable.

Conclusion

The applicant believes that it has responded to all of the issues raised in the office action and submits that all of the pending claims are allowable. Thus, it is respectfully requested that the examiner pass the application to allowance. The examiner is invited to call the undersigned if there are any questions concerning the application.

Dated: March 2, 2004

Respectfully submitted,


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